

## REMARKS

### INTRODUCTION

Claims 1-22 and 28-57 were previously pending and under consideration.

Claims 1-22 and 28-57 have been cancelled.

Claims 58-75 have been added.

Therefore, claims 58-75 are now pending and under consideration.

No new matter is being presented, and approval and entry are respectfully requested.

### REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

In the Office Action, the previously pending claims were rejected under 35 U.S.C. § 112, second paragraph. The rejection proposed that the claim recitations "[some feature] is larger/less than would be necessary to [do something]" was not clear. The previous rejection stated that "It is unclear what would be necessary to [do the something]".

A claim that "apprises one of ordinary skill in the art of its scope" meets the requirement of § 112, second paragraph (see MPEP § 2173.02). Claim 1, for example, recites:

a light-emission intensity of at least one of the fluorescent substances of red, green and blue is set to be larger than would be necessary *to display an intended white color by simultaneous **unfiltered** light emission of the fluorescent substances of red, green and blue*, so that light within the wave range is emitted with intensity to compensate for attenuation of light within the wave range absorbed by the filter...

For the sake of the following discussion, the "one of the fluorescent substances" is deemed to be red. It is ordinary knowledge in the art of display technology to produce an intended color from a combination of color components. Reading claim 1, one of ordinary skill in the art need only understand what light-emission intensity of the red fluorescent substance (for example) would be necessary to produce, in combination with the blue and green substances,

an intended white color without filtration. And, one skilled in the art would understand that any larger intensity would be "larger than necessary" to simultaneously produce the intended white color if unfiltered. Given red, blue, and green fluorescent substances, one skilled in the art readily knows what component intensities of red, blue, and green are needed to simultaneously produce an intended or desired color, whether the intended or desired color is white or some other color. For example, if color W is intended, one skilled in the art can readily determine that intensities of red=8, blue=10, and green=9 are necessary to simultaneously produce the color W. In the example, one skilled in the art would also understand that any intensity of red that is greater than 8 would be an "intensity ... larger than would be necessary to display" the color W without filtering. The necessary intensity would be clear and well defined. In sum, the "larger/smaller" than language in the claims is clear to one skilled in the art of display technology.

One of ordinary skill in the art of display technology would also understand that the recited intensity is such "that light within the [filter's] wave range is emitted with intensity to compensate for attenuation of light within the wave range absorbed by the filter". One of ordinary skill in the art of display technology would understand that the recited intensity may be determined from the attenuation of the filter. Again, there is nothing unclear about defining an intensity in terms of corresponding attenuation by a filter.

In further support of the use of this type of language, it is respectfully noted that a search of the PTO's online database shows that there are at least hundreds of issued patents that recite "larger than necessary" type language. See, for example, U.S. Patent 5,125,624 ("at least one of said slots being larger than necessary for said stem and said disc to interfit with each", claim 1), and U.S. Patent 6,473,102 ("adjusting the window so that it is no larger than necessary to accommodate the second number of information units", claim 31).

Finally, Applicant respectfully notes that according to MPEP § 2173.02, "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C.112, second paragraph is appropriate, ... **an analysis as to why** the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office action." Applicant respectfully requests that any further § 112, second paragraph rejection provide the required analysis. The previous rejections stated only a conclusion ("It is unclear what would be necessary ...") without any accompanying

analysis of why the cited portions of the claims were unclear.

## **REJECTIONS UNDER 35 USC §§ 102 AND 103**

In the Office Action, claims were rejected under 35 U.S.C. § 102 as anticipated by Ueoka. Claims were also rejected under 35 U.S.C. § 103 as anticipated by Ueoka in view of Asano and Raber. These rejections are traversed and reconsideration is requested.

### **CLAIM 58**

Claim 58 recites "a filter having a characteristic of absorbing light within a wave range of visible light emitted by the discharge gas". Furthermore, claim 58 recites "a light-emission intensity of at least one of the fluorescent substances of red, green and blue is set to be larger than would be necessary to display an intended white color by simultaneous unfiltered light emission of the fluorescent substances of red, green and blue, so that light within the wave range is emitted with intensity to compensate for attenuation of light within the wave range absorbed by the filter". One of the fluorescent substances has a selective light-emission according to the filter. The prior art does not discuss or suggest this feature.

Furthermore, claim 58 recites a filter on the front side of the front substrate. In contrast, the filter in Ueoka is disposed on the display side of the front substrate. Ueoka, column 6, lines 40-47 discuss a filter "applied onto the *display side surface* [i.e. the side facing the display, not the front] of substrate 1 [the front substrate]". See substrate 1 of Figure 2.

### **CLAIMS 63-68**

Claims 63-68 approximately correspond to previous claims 10-15. Claims 10-15 were rejected as reciting "an element capable of performing a function", which was suggest to be "not a positive limitation but only requires the ability to so perform." None of former claims 10-15, or new claims 63-68 recite "capable of" or the like. Claims 63-68 and others recite positive limitations – characteristics – not found or cited in the prior art.

Furthermore, the Examiner is respectfully directed to U.S. Patent 6,479,928. Claim 1 of this patent recites "at least one filter layer, coated on the inner surface of said glass panel ... having at least one absorption peak at a predetermined wavelength..." See also U.S. Patent 6,534,904, claim 5, which recites a "maximum emission wavelength ranges from 2.3

micrometers to 2.7 micrometers". A review of numerous issued patents confirms the standard practice in the display and optical arts of using functional or characteristic qualifications of structural elements. Reciting an optical property of an optical component is an established method of defining its necessary structural characteristics. See also MPEP § 2111.02, stating that "*Any terminology* in the preamble [or body] that limits the structure of the claimed invention **must** be treated as a claim limitation." See also MPEP § 2173.05(g), stating that "A functional limitation **must** be evaluated and considered, **just like any other limitation of the claim.**"

Prior rejections have cited § 2114 of the MPEP. However, this section of the MPEP does not negate the patentable weight that must be given to functional or characteristic limitations of structural elements that characterize differences over the prior art. Rather, § 2114 of the MPEP relates to cases holding that an apparatus with identical structure cannot be differentiated by the overall function (e.g. intended use) of the claimed apparatus. A structure - such as a filter or a display element - that has a recited static characteristic must necessarily differ from a prior art element that does not have that characteristic. For example, if a filter is recited as attenuating in a wave range, the filter necessarily has a structure (e.g. composition, thickness, etc.) that attenuates in the wave range. A prior art filter that does not attenuate in the wave range cannot have the same structure.

Referring again to § 2114 and the cases cited therein, *In Re Scribe* held that an intended overall functional use cannot distinguish otherwise identical structure. *In Re Swinehard* was a holding on § 112 not related to distinguishing over prior art. *In Re Danly* held that defining structure as enabling a *possible* function does not distinguish the structure when the same function is found in the prior art. *Hewlett Packard* held that "An invention need not operate differently than the prior art to be patentable, but need only be different". Being different can entail a static characteristic of the structure. None of the cases cited in § 2114 invalidate the well established practice of limiting structure by defining the characteristics (static functional properties) of the structure.

## DEPENDENT CLAIMS

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 61 recites "each of the discharge cells further comprises a light-emission region and an area of the same, and where the discharge cells having the red fluorescent substance have areas larger than the areas of the discharge cells having the blue and green fluorescent substances". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 4, 2003  
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Date: August 4, 2003